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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,901	05/24/2001	Valerie Baubet	03495.0207-00000	9364

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EXAMINER

MAYES, LAURIE A

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 07/07/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,901

Applicant(s)

BAUBET ET AL.

Examiner

Laurie Mayes

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 9, 15-19, 26, 27, 32, 33 and 38-56 is/are pending in the application.
- 4a) Of the above claim(s) 1, 9, 16-19, 27 and 46-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 3, 26, 33 and 39-44 is/are rejected.
- 7) ☒ Claim(s) 15, 38 and 45 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group II, claims 2, 3, 15, 26, 33, 38-52, as drawn to SEQ ID NOS: 5 and 22 only in Paper No. 11 is acknowledged. As claims 46-52 are drawn to sequences other than the elected SEQ ID NOS: 5 and 22, these claims are treated as non-elected claims and are not examined.

Specification

The use of the trademarks PHOTEK (para. 99), BERTHOLD (para. 98, 102-104), ROCHE (para. 98), RUGENE (para. 97) have been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Information Disclosure Statement

The listing of references in the specification on pages 37-38 is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Art Unit: 1653

Claim Objections

Claims 15, 38 and 45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 33 and claims 39, 40 and 42 dependent thereon, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 33 the language a "peptide linker of at least 5 amino acids comprising . . . SEQ ID NO: 22" is redundant as SEQ ID NO: 22 has 50 amino acid residues and any linker comprising SEQ ID NO: 22 must have at least 5 amino acids and in fact must have at least 50 amino acids.

Claim 39 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 39 the language "linker has the capacity to stabilize" is indefinite. Does the linker stabilize or not?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Art Unit: 1653

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 33 and 39 are rejected under 35 U.S.C. 102(a) as being anticipated by Blair et al. (WO 99/49041). Blair et al. teach a peptide linker comprising the amino acid residues "Ser Gly Leu Arg Ser" (SEQ ID NO: 30, a.a. 240-244), five contiguous amino acids found in SEQ ID NO: 22 of the present application (present claim 33) wherein the peptide linker results in a fluorescent protein with greater stability (p. 25, lines 11-16) (present claim 39). Blair et al. teach all of the elements of claims 33 and 39 and these claims are anticipated under 35 U.S.C. 102(a).

Claim 2 is rejected under 35 U.S.C. 102(b) as being anticipated by Pritchett et al. (US 5,714,666). Pritchett et al. teach a composition comprising apoaquorin which binds calcium ions and transmits measurable energy wherein the amount of energy and quantity of calcium bound changes with the concentration of apoaquorin (col. 3, lines 2-10) (present claim 2). Pritchett et al. teach all of the elements of claim 2 and this claim is anticipated under 35 U.S.C. 102(b)

Art Unit: 1653

Claim 33 is rejected under 35 U.S.C. 102(b) as being anticipated by Masucci (US 5,833,991). Masucci teaches a peptide linker comprising at least five amino acid residues as found in SEQ ID NO: 22 (see attached copy of sequence alignment; SEQ ID NO: 1, cols. 29-30)(present claim 33). Masucci teaches all of the elements of claim 33 and it is anticipated under 35 U.S.C. 102(b).

Claim 44 is rejected under 35 U.S.C. 102(e) as being anticipated by Campbell (US 6,492,500). Campbell teaches a fusion protein comprising GFP (col. 3, lines 25-30), a linker of four amino acids (col. 5, lines 30-35), and aequorin (col. 3, lines 32-36). Campbell teaches all of the elements of claim 44 and this claim is anticipated under 35 U.S.C. 102(e).

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Mayes whose telephone number is (703) 605-1208. The examiner can normally be reached on Monday through Friday from 9 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (703) 308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

Art Unit: 1653

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1123.



Laurie Mayes
Patent Examiner
Art Unit 1653
June 20, 2003



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